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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,476	10/27/2004	Nagaaki Sato	2004-1297A	3640

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WENDEROTH, LIND & PONACK, L.L.P.  
2033 K STREET N. W.  
SUITE 800  
WASHINGTON, DC 20006-1021

EXAMINER

MORRIS, PATRICIA L

ART UNIT PAPER NUMBER

1625

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/505,476

Applicant(s)

SATO ET AL.

Examiner

Patricia L. Morris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 17, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 5 and 10-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-14, 19 and 20 are under consideration in this application.

Claims 15, 16 and 16 are held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

#### ***Election/Restrictions***

Applicant's election without traverse of Group I and the process of claim 17 in the reply filed on January 13, 2006 is acknowledged.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-9, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (WO 01/627738).

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Sato et al. teach the compounds excluded by proviso herein in claim 16 and examples 12-4 therein. The prior art compound differs from the compound claimed herein as a halogen analog or positional isomer of the claimed compound. For example, the instant compounds wherein  $R^1$  is hydrogen, 6-fluoro-3-pyridyl and 3-fluorophenyl are position isomers of the prior compound. Also, compounds wherein one of  $R^2 - R^5$  is a halogen other than fluorine are halogen analogs of the prior art compounds. One having ordinary skill in the art would have been motivated by the disclosure of the prior art compound to arrive at other compounds within the claimed genus. The motivation to make these compounds is their close structural similarities to the disclosed compound. While homology is considered to be present even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art.

Attention, in this regard is directed to *In re Druey et al.*, 50 CCPA 1538, 319 F.2d 237, 138

USPQ 39, wherein Judge Worley, delivering the Court's opinion, stated:

that in "We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants the term homologue is used by chemists at times in a broad sense, and at other times a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

Also, as the Court stated in *In re Payne et al.*, 606 F.2d 302, 203 USPQ 245 at 255 (CCPA 1979):

"the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound."

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In addition, any question of why would one conceive and use the similar compounds (i.e. “motivation”) is answered by the Court in *In re Gyurik et al.*, 596 F.2d 1012, 201 USPQ 552 at 557.

“In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the prima facie case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al.

Sato et al. disclose the instant process. Note claim 19 therein. As here, a compound of formula (II) is reacted with a compound of formula (VI) followed by an intramolecular ring closure condensation and optional cleavage of the protecting group. The reaction of a specific compound of formula (II) with a specific compound of formula (VI) does not render the process itself patentable, anew; *In re Albertson*, 141 USPQ 730, which was specifically reaffirmed on the last page of *In re Kuehl*, 177 USPQ 250.

One having ordinary skill in the art would have been motivated to employ the process of the prior art with the expectation of obtaining the desired product, because he would have expected the analogous starting materials to react similarly. It has been held that application of an old process to a new and analogous material to obtain a result consistent with the teachings of the art would have been obvious to one having ordinary skill.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is not a proper composition claim since it fails to recite the presence of an inert carrier.

***Allowable Subject Matter***

Claims 5 and 10-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Claims 1-4, 6-9, 17 and 19-20 are not allowed.

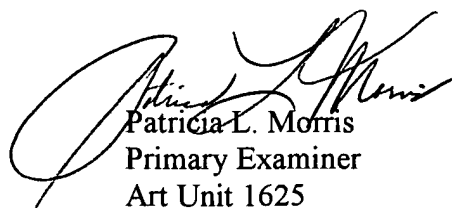
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Morris  
Primary Examiner  
Art Unit 1625

plm  
February 23, 2006